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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/580,156 05/30/00 SANDBERG L 97-489-US-F

EXAMINER

HM12/1003

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ART UNIT

PAPER NUMBER

1631
DATE MAILED:

10/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/580,156

Applicant(s)

Sandberg et al.

Examiner

Michael Borin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1631

Part III DETAILED ACTION

Claims 1-20 are pending.

Restriction Requirement

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, 13, 19, 20 (all in part), drawn to elastin fragments of SEQ ID Nos.: 1-48 and compositions thereof, classified in class 514, subclasses 15-18, and class 530, subclasses 328-330.
- II. Claims 1-11, 13, 19, 20 (all in part), as drawn to compositions comprising cyclic peptides (SEQ ID Nos: 48-51), classified in class 514, subclass 9.
- III. Claims 1-11 (all in part), as drawn to compositions comprising copper salts of peptides (SEQ ID No.52-54), classified in class 514, subclass 6.
- IV. Claims 15-18(all in part), drawn to method of enhancing tissue elasticity using elastin fragments, classified in class 514, subclasses 15, 16.
- V. Claims 15-18 (all in part), as drawn to method of enhancing tissue elasticity using cyclic peptides (SEQ ID Nos:48-51), classified in class 514, subclass 9.
- VI. Claims 15-18 (all in part), as drawn to method of enhancing tissue elasticity copper salts of peptides (SEQ ID No. 52-54), classified in class 514, subclass 6.

Art Unit: 1631

VII. Claims 12, 14, drawn to peptide of general formula of claim 12, classified in class 530, subclass 330.

The inventions are distinct, each from the other because of the following reasons:

The linear peptides, copper salts and cyclic peptides of Groups I-III are drawn to independent and/or patentably distinct compounds since each of these compounds possess different structure (e.g., primary, secondary and tertiary structure) and/or physico-chemical properties, and/or capable of separate manufacture and/or use. The correspondent methods of use IV-VI are independent and/or distinct due to the use of different patentably distinct agents.

Inventions I-III and IV-VI are related as products and respective processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products as claimed can be used in a materially different processes such as peptide synthesis or in pharmaceutical formulations. Further, the method as claimed can be used with other products, such as elastin.

Inventions I and VII are patentably distinct from each other because of the materially different structures of the compounds they are claiming. The scope of the genus of claims 12, 14 is different from the selection of particular peptides of Group I. The genus of Group VII does not include all peptides of Group I (e.g., tripeptides). It is noted that Groups I and VII share certain

Art Unit: 1631

species (of claim 13; the latter is assigned to Group I). If the common species, Groups I and VII will be examined together to the extent they read on elected species.

Because these inventions are distinct for the reasons given and have acquired a separate status in the art because of their recognized divergent subject matter, and the necessity for non-coextensive literature searches restriction for examination purposes as indicated is proper.

Upon election of any single one of the Groups from above the following election of species is hereby required:

Species Requirement

Election of species should be required prior to a search on the merits in all applications containing both species claims and generic or Markush claims.(MPEP 808.01(a))

Upon election of any single one of the Groups from above the following election of species is hereby required for the initial search for examination on merits:

The claims of the Group are individually or dependently directed to a plurality of disclosed patentably distinct species of peptides which are not a result of conservative substitutions of amino acid residues. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, such as those in claim 1, 13 or 15.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds

Art Unit: 1631

one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

September 26, 2001

MICHAEL BORIN, PH.D
PRIMARY EXAMINER

mlb

